

### **REMARKS**

Further and favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

The proposed amended claims place the application in better condition for allowance and/or appeal, and present no new issues for consideration as they are drawn to the specific claimed polynorbornene compositions which have already been examined. Entry of the amendment under 37 CFR 1.116 is respectfully requested.

#### **(I) Disposition of Claims**

- (i) Claims 1, 5, 8, 10-22, 24-25, 27, 29, 31 & 33 are pending in the application.
- (ii) No Claims have been withdrawn from consideration.
- (iii) Claims 2-4, 6-7, 9, 23, 26, 28, 30 & 32 have been canceled from the application.
- (iv) Claims 1, 5, 8, 10, 12-15, 20-22 and 24 stand rejected under 35 U.S.C. § 102.
- (v) Claims 1, 5, 10, 11, 14-19, 19-22, 24-25, 27, 29, 31 and 33 stand rejected under 35 U.S.C. § 103.

#### **(II) Applicants' Actions**

Claims 1, 8, 22, 25, 31 and 33 are amended to exclude the polymer compositions of the cited references. No new matter has been added.

#### **(III) Claim Rejections – 35 USC § 102(e)**

Claims 1, 8, 10, 12-13 and 22 stand rejected under 35 USC §102(e) as being anticipated by U.S. Patent Appl. Pub. No. 2004/0084774 Li et al. (hereinafter "Li"). This rejection is respectfully traversed.

The copolymers of Li fall outside the scope of the amended claims.

(IV) Claim Rejections – 35 USC § 102(b)

Claims 1, 5, 8, 10, and 22 stand rejected under 35 USC §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 10-251343 (hereinafter “JP ‘343”). This rejection is respectfully traversed.

The JP ‘343 repeat unit A is always present in the composition of JP ‘343, has two fused bi-cyclic structures, and falls outside the scope of the amended claims.

(V) Claim Rejections – 35 USC § 102(b)

Claims 1, 5, 10, 14-15, 20-22 and 24 stand rejected under 35 USC §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 6,492,443 to Kodemura et al (hereinafter “Kodemura”). This rejection is respectfully traversed.

Kodemura uses a ring opening polymerization and subsequent hydrogenation to make an entirely different polymer than claimed polynorbornenes, and thus Kodemura falls outside the scope of the amended claims.

(VI) Claim Rejections – 35 USC § 103

Claims 16, 19 and 33 stand rejected under 35 USC §103(a) as being obvious over U.S. Patent No. 6,492,443 to Kodemura et al (hereinafter “Kodemura”). This rejection is respectfully traversed.

As discussed above Kodemura does not anticipate the composition of the amended claims. Furthermore, Claim 33 requires the claimed polynorbornene of the previously argued claims and the aforementioned arguments are incorporated herein by reference.

The Examiner has provided no motivation why one of ordinary skill in the art would modify Kodemura to obtain **only** the claimed polynorbornene.

(VII) Claim Rejections – 35 USC § 103

Claims 16-19, 25, 27, 29, 31 and 33 stand rejected under 35 USC §103(a) as being obvious over U.S. Patent No. 6,492,443 to Kodemura et al in view of

U.S. Patent No. 5,470,643 to Dorfman (“hereinafter Dorfman”). This rejection is respectfully traversed.

Dorfman does not remedy the deficiencies of Kodemura.

(VIII) Claim Rejections – 35 USC § 103

Claims 16-18, 25, 27, 29, 31 and 33 stand rejected under 35 USC §103(a) as being obvious over JP ‘343 in view of Dorfman. This rejection is respectfully traversed.

As discussed above JP ‘343 does not anticipate the composition of the amended claims. Furthermore, Claim 33 requires the claimed polynorbornene of the previously argued claims and the aforementioned arguments are incorporated herein by reference.

The Examiner has provided no motivation why one of ordinary skill in the art would modify JP ‘343 to obtain **only** the claimed polynorbornene.

Dorfman does not remedy the deficiencies of JP ‘343.

(X) Claim Rejections – 35 USC § 103

Claim 11 stands rejected under 35 USC §103(a) as being obvious over JP ‘343 in view of JP 04214778. This rejection is respectfully traversed.

JP 04214778 does not remedy the deficiencies of JP ‘343.

In view of the foregoing, allowance of the above-referenced application is respectfully requested. Applicants invite the Examiner to contact the undersigned in case of questions. Please charge any unaccounted fee that may be due, to Deposit Account No. 04-1928 (E. I. du Pont de Nemours and Company).

Respectfully submitted,

/Brian C. Jones/

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